

REMARKS

I. Summary of Office Action

Claims 1-6, 8-14 and 16-21 are pending in the above-identified patent application.

In the May 24, 2004 Office Action claim 15 was indicated to be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. The present Office Action contends that this previous indication was in error and withdrew such indication.

Claims 1-6, 8-14 and 16-21 were rejected under 35 U.S.C. § 103(a) as being obvious from Pugliese, III et al. U.S. patent publication No. US 2001/0044751 (hereinafter "Pugliese") in view of Messmer et al. U.S. patent publication No. US 2001/0037278 (hereinafter "Messmer") and further in view of Sowinski U.S. patent 6,601,033 (hereinafter "Sowinski").

II. Summary of Applicants' Reply to Office Action

Applicants' August 25, 2004 Reply to Office Action amended the originally-filed independent claims 1 and 21 to incorporate the feature of originally-filed dependent claim 15, which had previously been indicated as allowable. The present Office Action withdrew the indication of allowability. As such, claims 1 and 21 have been amended to restore the claim language as originally-filed. Claim 22 has been added to restore originally-filed dependent claim 15. No new matter has been added by these amendments and the claims are fully supported and justified by the application as originally filed.

The Office Action's rejections are respectfully traversed.

III. Rejections of the Claims

The Office Action contends that claims 1-6, 8-14 and 16-21 are obvious from Pugliese in view of Messmer and further in view of Sowinski. The MPEP clearly states that "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." See MPEP §2143. However, applicants submit that the Office Action has failed to provide any sufficient motivation for combining the references, and that the combination of references would not even show or suggest all the features of applicants' claimed invention. Therefore, the rejection under 35 U.S.C. § 103 lacks at least two of the three prongs required for a rejection under 35 U.S.C. § 103.

Applicants' independent claims 1 and 21 are directed towards an electronic trading simulation that simulates the trading of carbon dioxide equivalent emission reductions. Entities may participate in applicants' simulated trading environment prior to, for example, their entry into an actual trading environment.

As set forth in applicants' Reply to the Office Action mailed November 10, 2003, Pugliese discloses an online shopping environment meant to "[mimic] a live shopping experience" (Pugliese, page 1, paragraph [0008]), in which a user makes actual purchases from a vendor. Thus, Pugliese does not disclose a "simulation" as defined by applicants' claims, but rather an actual shopping environment. The present Office Action appears to contend both that Pugliese *does* and *does not* disclose an electronic trading simulation. In particular, the Office Action states that "[t]he Pugliese reference discloses a method for simulating trading" in which "a user [is allowed] to participate in an electronic trading simulation" and "a simulation administrator [is allowed] to modify parameters in connection with the electronic trading simulation in real-time" (Office Action, page 2). The Office Action then states that "[t]he Pugliese reference lacks [that] the system is for simulating trading" (Office Action, page 3). Clearly, these statements are contradictory. However, because the Office Action proceeds to use the Messmer reference to attempt to show a trading simulation, applicants assume that the Office Action's contention is that Pugliese *does not* disclose a trading simulation. Applicants' will proceed with this assumption to respond to the present Office Action's arguments.

A. The Combination of Pugliese with Sowinski

In connection with the combination of Pugliese and Sowinski, the Office Action contends that "it would have been obvious to combine the 'goods' (i.e., carbon monoxide reductions) of the Sowinski patent with the 'goods' of the

Pugliese patent so as to reach an expansive audience yet provide a reasonable means of trading reductions" (Office Action, page 3). Applicants respectfully disagree. In particular, applicants submit that the Pugliese system would not be a "reasonable means of trading" the pollution credits of Sowinski. As described hereinabove, Pugliese discloses an online shopping environment that is meant to mimic an actual shopping experience (e.g., that of a shopping mall). Pugliese discloses a live salesperson who can interact with shoppers to "[show] them a product via networked live Internet enabled cameras" (Pugliese, page 1, paragraph [0008]).

The shopping environment of Pugliese is inappropriate for the establishment of pollution credits disclosed in Sowinski. "Goods" such as those found in shopping malls and disclosed in Pugliese -- i.e., those that require photographs so that a shopper can see them online -- are not interchangeable with the "pollution credits" of Sowinski. Trading pollution credits involve trading a product that is dissimilar to these "goods." For an industrial user, viewing a "physical" pollution credit is not a relevant need like viewing a "good" is for an ordinary consumer. In fact, when trading pollution credits, these items are unlikely to be viewed. Therefore, one of ordinary skill in the art at the time of the Sowinski invention is unlikely to be motivated to look to Pugliese. Another reason one would not be motivated to combine these references is that the pollution credits of Sowinski involve a complicated regulatory scheme that is unnecessary and therefore not present in the online shopping environment of Pugliese. The Office Action has also failed to provide support

as to how such a combination would provide a "reasonable means of trading" the pollution credits of Sowinski. Thus, the Office Action has failed to provide a sufficient motivation for one of ordinary skill in the art to combine Pugliese with Sowinski.

B. The Combination of Pugliese with Messmer

In connection with the combination of Pugliese with Messmer, the Office Action contends that "[i]t would have been obvious to one of ordinary skill in the art to modify the Pugliese system to include that it may be used for simulating a bidding system so as to provide users with a mechanism that will give them the best optimal conditions prior to entering an actual market" (Office Action, page 4). Applicants assume that the Office Action has derived this motivation from the disclosure of Messmer. However, the Office Action's motivation to combine Pugliese with Messmer is one of the very problems Messmer sets out to resolve. In particular, Messmer discloses a system that examines "[s]imulated bid scenarios . . . for combinations of bid prices and a best bid price according to risk and return" so that a trader can make the optimal bid (Messmer, Abstract). Thus, one of ordinary skill in the art would look no further than Messmer to determine "the best optimal conditions prior to entering an actual market," as this is what Messmer already sets forth in its disclosure. Accordingly, the Office Action has failed to provide a sufficient motivation for combining Pugliese with Messmer.

C. The Office Action's Contention
Regarding "Tests" and "Simulations"

The Office Action also contends that applicants' claimed invention is merely a "test" of a trading system, and that "it would have been obvious to one of ordinary skill in the art at the time the invention was made that the Pugliese system could have been used as a simulated trading system" (Office Action, page 4). Contrary to the Office Action's contention, applicants' claimed invention is not a "test" of a trading system, "run prior to actually launching such [system]" (Office Action, page 4). In fact, applicants submit that a "test" is inherently different from a "simulation" such as the simulation set forth in applicants' claims. A test of a computer program is conducted to ensure that the computer program itself is functioning properly prior to, for example, selling the program to the public. Such tests allow a programmer to debug the program so that it functions properly. In contrast, a simulation is conducted to facilitate a user's future participation in an actual event. For example, as set forth in applicants' specification:

[E]ntities such as countries, corporations, or non-profit organisations may desire to simulate their participation prior to entry [into an actual trading environment] to gain a deeper understanding of the market. Such entities may, for example, need to understand their emission profiles, assess their potential obligations and associated liabilities, and learn to trade CO₂e emissions reductions.
(Applicants' specification, paragraph [0004]).

Thus, the trading simulation of applicants' claims facilitates a user's future participation in an actual trading environment.

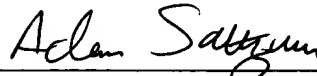
The inherent difference between a "test" and a "simulation," as described herein, manifests itself in an important difference in the computer applications involved. For a "test," a computer program is in the debugging stage, in which a programmer is still making modifications to the program. For a "simulation," the computer application involved is a finished product, ready to be used by a user. Thus, applicants respectfully submit that because "tests" are not the same as "simulations," it would not have been obvious to use the Pugliese system as a simulated trading system.

Accordingly, applicants' respectfully submit that at least because the Office Action has failed to provide any sufficient motivation for combining Pugliese with Sowinski and Messmer, the rejection of claims 1-6, 8-14 and 16-22 under § 103 should be withdrawn.

IV. Conclusion

The foregoing demonstrates that claims 1-6, 8-14, and 16-22 are patentable. This application is therefore in condition for allowance. Reconsideration and prompt allowance are accordingly respectfully requested.

Respectfully submitted,



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